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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,636	12/12/2003	Soo-Jin Park	P56916	1649

7590 01/24/2005
Robert E. Bushnell
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Washington, DC 20005

EXAMINER

DESAI, RITA J

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/733,636	PARK ET AL.	
	Examiner	Art Unit	
	Rita J. Desai	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/12/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-4 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, in part, 5-10 and 12-14, drawn to compounds of formula I given by formulas 2-7 in claims 5-10, classified in class 546 and various subclasses.
- II. Claims 11, drawn to formula I wherein X is a bidentate ligand, classified in class 546 and various subclasses. A further election of a single disclosed species is required. May be subject to further restriction.
- III. Claims 1, 2, 3 and 4 drawn to formula other than in Group I, classified in various classes and subclasses. May be subject to further restriction.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different formula and a core. The bonding and function are hence different.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II or III, restriction for examination purposes as indicated is proper.

During a telephone conversation with Robert Bushnell on 1/5/05 the examiner gave the groups and applicants filed a response and a provisional election was made with traverse to prosecute the invention of Group I, claims 1-4, in part, 5-10 and 12-14, drawn to compounds of formula I given by formulas 2-7 in claims 5-10. Claims 1-4 in part and 11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

If applicant's traverse on the grounds that the inventions are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the groups to be obvious variants or clearly admit on the record that this is the case. In either instance if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 USC 103 of the other invention.

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Applicants have argued that it is not a burdensome search is not convincing. The core of the compounds of formula I have many variables. X has different formulas and hence the core is different and the search is different and burdensome.

The Restriction is made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites an image display device without specifying how the compound of the invention are used on it.

It is not clear how these are used, and also what the image display device it.

Clarification and amendment is required.

Claim Rejections - 35 USC § 103

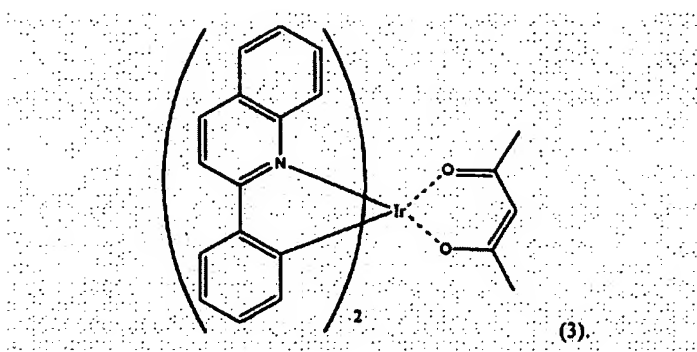
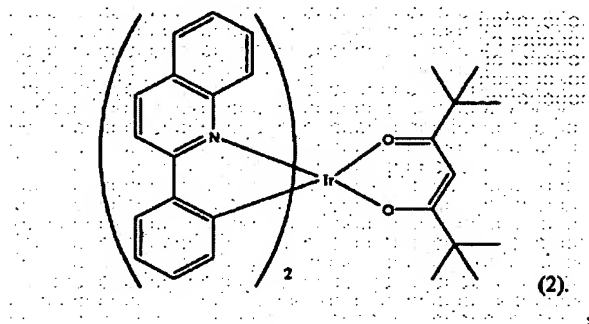
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

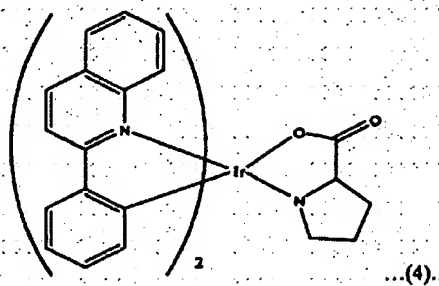
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Claims 1-10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 20002/0034656A1. March 2002.

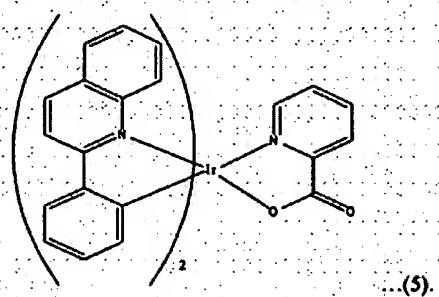
Applicants claims are drawn to compounds of the formula



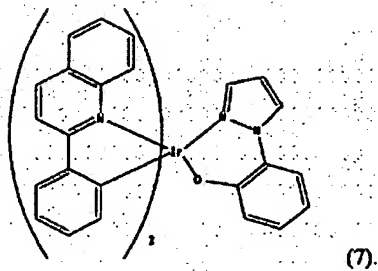
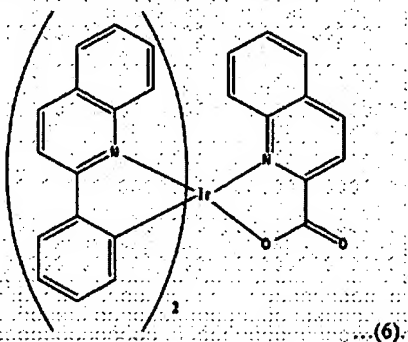
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The compound of claim 1, having the formula (5):



The compound of claim 1, having the formula (6):



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and also a method of using them as an organic layer in an electroluminescent device.

Determination of the scope and content of the prior art (MPEP §2141.01)

The US publication discloses similar Ir based compounds such as

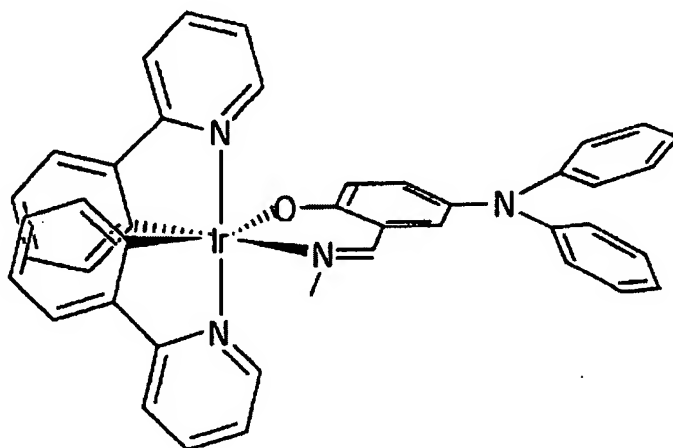
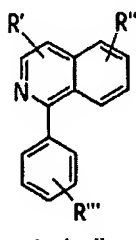


Fig. 16

Also see all the figures.

The different ligands are also taught. [see fig 49]



Applicants different X values are also taught in the US publication.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

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The difference is in the position of the phenyl ring with respect to the quinoline making it a positional isomers. Positional isomers are not considered to be patentably distinct unless there is a showing of unexpected results.

Applicants do not have any showing with a side by side comparison of unexpected results, since the prior art compounds also have the same use.

One of ordinary skill in the art would have been motivated to make the compounds of the invention based on the teachings of the publication.

Double Patenting

Claims 12-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1,2, 5 of copending Application No. 10/849945 and claims 1-3 of US 10/989644. Although the conflicting claims are not identical, they are not patentably distinct from each other because these also claim a device with a metal transmission layer.

Applicants claims are also drawn to a electroluminescent device with an organic layer which would have Ir .

US 10/989644 is drawn to a display device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

None of the claims are found to be allowable.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Rita J. Desai
Primary Examiner
Art Unit 1625

R.D.
January 21, 2005

1/21/05